

ATTORNEY DOCKET NO. 14114.0353U2
U.S. APPLN. NO. 09/937,862
CONFIRMATION NO. 8841

Remarks

Claims 1-46 are pending. Claims 3-5 and 12-46 are withdrawn from consideration. Withdrawn claims 3-5 and 12-46 are cancelled herein. Claims 1, 7 and 8 are amended herein. The present application has been amended to render the amended claims 1, 7 and 8 and claims 2, 6 and 9-11 allowable. Particularly, claim 1 is amended to delete reference to non-elected SEQ ID NOs:20 and 21. Claim 1 is also amended to delete reference to SEQ ID NO:22. Claim 7 is amended to delete reference to non-elected SEQ ID NOs:20 and 21. Claim 8 is also amended to delete reference to non-elected SEQ ID NOs:20 and 21. No new matter has been added by way of these amendments. Also, since no new limitations are presented by these amendments, no new issues are presented. Thus, entry and consideration of the presently amended claims are respectfully requested.

I. Election/Restrictions

The Office Action states that claims 3-5 and 12-46 are drawn to an invention nonelected with traverse in Paper No. 9. Claims 3-5 and 12-46 are withdrawn from consideration. Withdrawn claims 3-5 and 12-46 are cancelled herein as requested.

The Office Action further states that Claim 1 has been amended to recite non-elected SEQ ID NOs:20 and 21. Claim 1 is amended herein to delete reference to non-elected SEQ ID NOs:20 and 21.

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The Office Action states that claims 7 and 8 recite non-elected species, SEQ ID NOs:20 and 21. Claims 7 and 8 are amended herein to delete reference to SEQ ID NOs:20 and 21.

II. Rejections Under 35 U.S.C. §102(a)

The Office Action states that claims 1, 2, 6 and 9-11 are rejected under 35 U.S.C. 102(a) as being anticipated by Kilpatrick (WO 98/14611).

Applicant respectfully asserts that the claims as amended overcome this rejection. Claim 1 is amended herein to delete reference to SEQ ID NO:22. Applicant respectfully submits that Kilpatrick does not anticipate amended Claim 1, and that the rejection under 35 U.S.C. §102(a) should be withdrawn as to amended Claim 1 and to dependent Claims 2 and 9-11.

Claim 6, although reciting SEQ ID NO:86, which is cited by the Examiner as anticipated by Kilpatrick SEQ ID NO:2, is novel over Kilpatrick for the following reasons. Claim 6 is directed to the method of claim 2 wherein at least one oligonucleotide comprises a sequence hybridizing to a motif chosen from the group consisting of the sequences given by SEQ ID NO:83, SEQ ID NO:84, and SEQ ID NO:85 and wherein at least one oligonucleotide comprises a sequence that hybridizes to a sequence encoding a motif given by SEQ ID NO:86. Thus, claim 6 is directed to a method including a mixture of SEQ ID NO:86 with one of the other listed SEQ ID NOs.

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Even if SEQ ID NO:86 is anticipated by Kilpatrick, the use of SEQ ID NO:86 with one of the other SEQ ID NOs is not anticipated. The logic of this argument appears to have been accepted by the Examiner in the current Office Action because the Examiner recognized the allowable subject matter of claims 7 and 8, which also include allegedly anticipated SEQ ID NO:22 in combination with other non-anticipated SEQ ID NOs. This logic can be contrasted with the Examiner's current rejection of claim 1 based on SEQ ID NO:22, where the allegedly anticipated SEQ ID NO:22 was a part of the Markush Group itself. Applicant has complied with the Examiner's request regarding claim 1 by deleting reference to SEQ ID NO:22 from the Markush Group of claim 1. Applicant respectfully asserts, however, that amendment of claim 6 is not necessary, and request that the rejection of claim 6 based on Kilpatrick be reconsidered.

III. Conclusion

Withdrawn claims 3-5 and 12-46 are cancelled herein as requested. Claim 1 is amended to overcome the Examiner's 102(a) rejection based on Kilpatrick. Moreover, claim 1 is amended to delete reference to non-elected sequences. Therefore, Applicant believed claim 1 is in condition for allowance. Because claim 1 is believed to be in condition for allowance, dependent claims 2 and 9-11 are also believed to be in condition for allowance. Claims 7 and 8 are amended to delete reference to non-elected sequences. Moreover, because Applicant believes that claim 1 has been amended into condition for

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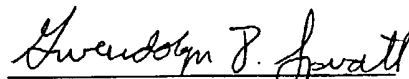
allowance, Applicant further believes that claims 7 and 8 are no longer dependent on a rejected base claim. Lastly, Applicant believes that the 102(a) rejection of claim 6 is overcome based on the arguments above.

In view of the above amendments and remarks, reconsideration and allowance of the pending claims is believed to be warranted, and such action is respectfully requested. The Examiner is invited and encouraged to directly contact the undersigned if such contact may enhance the efficient prosecution of this application to issuance.

No fee is believed due; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

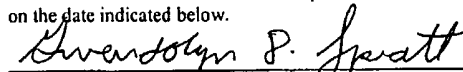
NEEDLE & ROSENBERG, P.C.


Gwendolyn D. Spratt
Registration No. 36,016

NEEDLE & ROSENBERG, P.C.
Customer Number 23859
(678) 420-9300
(678) 420-9301 (fax)

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7-6-04
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